



[11403/5]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

X

: Examiner: Ian N. Moore

Markus Klausner et al.

:

For: WIRELESS ACCESS TO CLOSED  
EMBEDDED NETWORKS

:

Filed: October 12, 2000

: Art Unit: 2661

Serial No.: 09/687,181

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GERARD A. MESSINA  
APPEAL BRIEF TRANSMITTAL  
AND PETITION TO EXTEND (33,865)

SIR:

Accompanying this Appeal Brief Transmittal is an Appeal Brief pursuant to 37 C.F.R. § 1.192(a) in triplicate (though not required) for filing in the above-identified patent application.

This is also a Petition to Extend Under 37 C.F.R. § 1.136(a) to extend the two-month response date by three (3) months from the two-month date of June 22, 2005 to September 22, 2005 (the Notice of Appeal was mailed on April 19, 2005 and filed in the Patent Office on April 22, 2005, which makes the two-month date of June 22, 2005).

Please charge the appropriate fees of \$1,520.00, which includes the Appeal Brief fee under 37 C.F.R. § 1.17(c) (which is believed to be \$500.00) and the Rule 136(a) extension fee (which is believed to be \$1,020.00 for the three-month extension), to Deposit Account No. 11-0600. The Commissioner is also authorized, as necessary and/or appropriate, to charge any additional and appropriate fees (including any further extension fees) or credit any overpayment to Deposit Account No. 11-0600. Two duplicate copies of this transmittal are enclosed for these purposes.

Respectfully submitted,

Dated: 9/22/2005

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In the Application of:

Markus Klausner et al.

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on

Date: *9/26/2005*  
Signature: *Aaron C. Bedrich*

*(33,865)*

**APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37**

SIR:

In the above-identified patent application ("the present application"), Appellants mailed a Notice Of Appeal on April 19, 2005 (which was filed on April 22, 2005) from the Final Office Action issued by the U.S. Patent and Trademark Office on November 19, 2004, so that the two-month appeal brief due date is June 22, 2005, which is extended by three months to September 22, 2005 by the accompanying Transmittal And Petition To Extend.

In the Final Office Action, claims 1, 3 to 17 and 19 to 33 were finally rejected.

An Amendment After A Final Office Action was mailed on March 18, 2005, and an Advisory Action was mailed on April 5, 2005. The Advisory Action does not specifically state whether the Amendment After Final of May 18, 2005 was entered, but it is understood, for purposes of the appeal, that the Amendment was entered by the Examiner (since the Examiner did not specifically say that the Amendment was not entered).

*As to the length of the "concise explanation" of the subject matter defined in each of the claims involved in the appeal (see 41.37), the "concise explanation" language is like the "concise explanation" requirement of former Rule 37 CFR 1.192. Accordingly, the length of the concise explanation provided is therefore acceptable, since it would have been acceptable under 37 CFR 1.192 and since it specifically defines the subject matter of the independent claims involved in the appeal. In the filing of many appeal briefs under the old rule for the present Assignee, the length of the "concise explanation" has always been accepted by the Patent Office.*

It is therefore respectfully submitted that this Appeal Brief complies with 37 § C.F.R. 41.37. Although no longer required by the rules, this Brief is submitted in triplicate as a courtesy to the Appeals Board.

It is respectfully submitted that the final rejections of claims 1, 3 to 17, and 19 to 33 should be reversed for the reasons set forth below.

**1. REAL PARTY IN INTEREST**

The real party in interest in the present appeal is Robert Bosch GmbH (“Robert Bosch”) of Stuttgart in the Federal Republic of Germany. Robert Bosch is the assignee of the entire right, title and interest in the present application.

**2. RELATED APPEALS AND INTERFERENCES**

There are no interferences or other appeals related to the present application, which “will directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal”.

**3. STATUS OF CLAIMS**

**Claims 2 and 18 are canceled.**

A. Claims 1, 3 to 11, 13 to 17, 19 to 27 and 29 to 32 were finally rejected under 35 U.S.C. § 102(b) as anticipated by Spaur et al., U.S. Patent No. 5,732,074.

B. Claims 12, 28 and 33 were finally rejected as obvious under 35 U.S.C. § 103(a) over the “Spaur” reference in view of the article reference by Horst Wunderlich et al., entitled “The Potential of Bluetooth in Automotive Applications”.

Appellants therefore appeal from the final rejections of claims 1, 3 to 17, and 19 to 33. A copy of all of the pending and appealed claims 1, 3 to 17, and 19 to 33 is attached hereto in the Claims Appendix.

**4. STATUS OF AMENDMENTS**

In response to the Final Office Action mailed on November 19, 2004, Appellants filed an Amendment After A Final Office Action, which was mailed on March 18, 2005, and an Advisory Action was mailed on April 5, 2005. The Advisory Action does not specifically state whether the Amendment After Final of May 18, 2005 was entered, but it is understood, for purposes of the appeal, that the Amendment was entered by the Examiner (since the Examiner did not specifically say that the Amendment was not entered).

It is also understood that all other Amendments have been entered to date.

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

The concise explanation of the summary of the claimed subject matter is as follows, as described in the context of the present application.

The following concern the exemplary embodiments and/or methods of the presently claimed subject matter:

Figure 1 shows a block diagram of the protocol translation according to an exemplary embodiment of the presently claimed subject matter. A first driver (the ‘in’ side of the Network Driver 100) receives a protocol message from a given network for translation, and then converts the message of the first protocol to a new, network-independent protocol, and then passes the message to a Message Dispatcher 102, which consults a Rules Database 104 to determine which of the Message Handlers 106 is to receive the network-independent message. The Message Handler 106 fills the destination fields of the message, uses specialized packet translation involving address changes, network changes segmentation/desegmentation, etc, is involved in the transfer, and then forwards the message to a Network Multiplexer 108, which consults the address and network fields of the message to identify the destination network. A Network Configuration Unit 110 configures and connects the gateway software components, and the Network Multiplexer 108 then passes the network-independent message to a second driver, the ‘out’ side of the Network Driver 100, which then converts the network-independent message to a second protocol message, which is forwarded to a third driver, External Driver 112, from which the message is used by a remote host. (See specification, page 3, line 21 to page 4, line 16).

Figure 2 shows this protocol translation system in an automotive environment, in which the vehicle bus 200 provides a pathway for data communication between various vehicle electronic components. The data message on the vehicle bus is accessed by a first network driver, ‘Network Driver - in’ 100, and is converted to a network-independent protocol, and then the message is passed to a Message Dispatcher 102, which uses a Rules Database 104 to determine which Message Handler 106 should receive the message. The Message Handler 106 fills the destination fields of the message and uses specialized packet translation involving address changes, network changes segmentation/desegmentation, etc., and the Network Multiplexer 108 passes the network-independent message to a second

driver, the ‘out’ side of the Network Driver 100, which then converts the network-independent message to a second protocol, which message is forwarded to a third driver, External Driver 112, from which the message is used by a remote computer 204. (See specification, page 4 line 17 to page 5, line 15).

Figure 3 provides a block diagram of a specific CAN-to-Bluetooth embodiment of the presently claimed subject matter, which concerns a node in an in-vehicle bus network that comprises gateway functionality for passing messages from the in-vehicle bus to a remote host, and a wireless communication chipset for establishing, maintaining, and controlling a wireless link between the node and at least one remote host. The presently claimed subject matter is described for a CAN as the in-vehicle communication protocol and Bluetooth as a short range wireless communication standard. The Bluetooth hardware 306 enables a wireless link to other Bluetooth hardware (309.1...309.n) connected to Bluetooth hosts (308.1...308.n) via an HCI, and this setup enables a remote application to communicate with the RSC 302. (See specification, page 5, line 17 to page 6, line 11).

The CAN controller 301 controls communication with the Vehicle Bus 200 (Figure 2), and signals in the CAN messages that pass the acceptance filter are passed on to the protocol converter 303, which retrieves CAN signals, computes the actual physical signal values (such as speed or RPM), and puts them in the payload of the target’s protocol data units (PDUs). The CAN signals may be directly assigned to data packets that can be sent via the host controller interface (HCI) to the Bluetooth host controller. The RSC 302 controls which signals are put in the PDUs. The gateway functionality of the protocol converter also includes the readressing (1:n) of messages based on subscriber management implemented in the RSC 302, the resequencing (i.e., changing the temporal order of received and retransmitted messages), and the changing of timing behavior. (See specification, page 6, lines 12 to 23).

If a packet-switched connection exists between CBWGN 307 and a remote application, the link between the CAN-connected Bluetooth host 305 and a remote Bluetooth host (308.1...308.n) is an asynchronous connection less link (ACL link). Next, the CAN signals are assigned to HCI ACL packets. One PDU may be assigned to each incoming CAN message, one PDU to each incoming signal, and one PDU to several incoming CAN messages and signals. The data rate and the throughput of the wireless link are factors that determine the allocation procedure. (See specification, page 7, lines 1 to 9).

In the exemplary embodiment, no remote application that connects to the CBGWN 307 has direct access to the CAN in the vehicle, so that no remote application can generate CAN messages, the transmission of which by the CBGWN 307 is supported as follows:

The RSC 302 stores a predefined set of CAN messages that are transmittable on the bus, along with the identifiers and rules for the messages that are transmitted, which ensure that the worst case bus load can be analyzed without any knowledge of future remote applications. CAN messages that the CBGWN 307 is allowed to transmit may include challenge response message schemes for diagnosis. When such a message is sent to an ECU, the ECU sends a reply containing failure codes or certain data from its memory. To initiate the transmission of challenge response messages, a remote application sends a request via a remote Bluetooth host (308.1...308.n) to the RSC 302. After authenticating and authorizing the remote application, the RSC 302 initiates the transmission of the messages via the CAN controller 301, and notifies the protocol converter 303 to assign the signals contained in the response messages to PDUs to be passed to the remote application. The protocol converter 303 has a priori knowledge of the start bits and length of the signals in each received CAN message that can pass the acceptance filter and assigns them to PDUs that can be interpreted by the remote Bluetooth host (308.1...308.n). For this purpose, in the CBWGN, a list is stored of CAN messages, its signals and the corresponding PDUs of the target protocol. (See specification, page 7, line 10 to page 8, line 8).

Each remote host (308.1...308.n) may be authenticated by the RSC 302, which verifies the subscription privileges (of the remote application) which concern the list of signals to which a remote application can subscribe, and which indicate whether the remote application is allowed to initiate challenge response schemes. A public key encryption method may be used, where the private key of the CBGWN 307 is stored in the CBGWN 307 and is unknown to others. Remote applications that want to subscribe to messages must obtain the public key for the CBGWN 307, which gives a manufacturer some control of the subscribers. Moreover, the public keys of the remote applications would be storable in the CBGWN 307, allowing only applications that have the corresponding private key to communicate with the CBGWN 307. (See specification, page 8, line 9 to page 9, line 2).

**In summary, the presently claimed subject matter of claim 1 is to a method for translating a message of a first protocol received by a first driver to a second protocol**

**transmitted by a second driver, including: receiving the message from the first driver by a message dispatcher before transmitting the message to a message handler, wherein the message dispatcher selects the message handler from a set of one or more message handlers by consulting a database; converting the message received by the first driver to an independent format; transmitting the message from the first driver to the second driver via the message handler; and converting the message received by the second driver in the independent format to the second protocol; where the first driver and the second driver are located in a vehicle and the first protocol is a vehicular protocol; and the second protocol is a wireless link. (See claim 1).**

*Finally, the appealed claims include no means-plus-function language and no step-plus-function claims, so that 41.37(v) is satisfied as to its specific requirements for such claims, since none are present here. Also, the present application does not contain any step-plus-function claims because the method claims in the present application are not “step plus function” claims because they do not recite “a step for”, as required by the Federal Circuit and as stated in Section 2181 of the MPEP.*

## **6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- A. Whether under 35 U.S.C. § 102(b), claims 1, 3-11, 13-17, 19-27 and 29-32 are anticipated by the Spaur reference.
- B. Whether claims 12, 28 and 33 are obvious under 35 U.S.C. § 103(a) over the Wunderlich reference.

## **7. ARGUMENT**

### **A. The Rejections Under 35 U.S.C. § 102(b) That Claims 1, 3-11, 13-17 and 19-32 Are Anticipated By the “Spaur” Reference**

#### **CLAIMS 1, 3-11, 13-17 and 19-32**

It is respectfully submitted that the “Spaur” reference does not identically disclose (or even suggest) each and every feature of the claimed subject matter.

Independent claim 1 relates to a method for translating a message of a first protocol received by a first driver to a second protocol transmitted by a second driver. The method according to claim 1 includes the features of receiving the message from the first driver by a message dispatcher before transmitting the message to a message handler, wherein the message dispatcher selects the message handler from a set of one or more message handlers by consulting a database. The method also includes the features of converting the message received by the first driver to an independent format; transmitting the message from the first driver to a second driver via a message handler; and converting the message received by the second driver in the independent format to the second protocol.

It is respectfully submitted that the “Spaur” reference does not discuss or even suggest — let alone identically disclose or describe — receiving a message from a first driver by a message dispatcher before transmitting the message to a message handler. The “Spaur” reference also does not identically describe that the message dispatcher selects the message handler from a set of one or more message handlers by consulting a database. The Office Action apparently relies on element 30 of figure 2 of the “Spaur” reference as disclosing the features of claim 2 (now canceled, since these features are now in claim 1). (Office Action; page 3, ll. 18-22). However, the Office Action also relies on element 30 of figure 2 as disclosing a message handler. (Office Action; page 3, ll. 3-5). This position is inconsistent as it requires element 30 of the “Spaur” reference to perform the function of the message dispatcher, to transmit a message to the same element 30, in purporting to perform the function of the message handler. Therefore, the Office Action requires that element 30 receive a message and transmit the message to itself, after selecting itself by consulting a database. This interpretation is contrary to the plain meaning of the claims and the specification of the presently claimed subject matter.

Additionally, the database referred to in the Final Office Action, assertedly data memory 106 and program memory 114, are also both part of element 30. Therefore, element 30 of the “Spaur” reference (which purportedly provides the functions of the claim) receives a message, consults itself to determine where to send the message, and in response transmits the message to itself. This interpretation of the claim, and the “Spaur” reference, deprives the claim of all meaning, and is therefore contrary to the law and reasoning. The “Spaur” reference does not identically disclose (or even suggest) receiving a message from a first driver by a message dispatcher before transmitting the message to a message handler,

Appeal Brief – 11403/5

wherein the message dispatcher selects the message handler from a set of one or more message handlers by consulting a database. Therefore, the “Spaur” reference does not anticipate the subject matter of claim 1.

Furthermore, the Office Action asserts that elements 106 (data memory) and 114 (program memory) of the “Spaur” reference disclose a database as in claim 1. However, there is no indication in the sections of the “Spaur” reference cited in the Office Action that either of elements 106 or 114 is consulted by a message dispatcher for selecting a message handler from a set of one or more message handlers, as in claim 1 as presented. In particular, data memory 106 apparently stores “data that has been generated and is expected to be useful in handling requests or commands.” (Spaur; col. 8, ll. 48-49). Similarly, program memory 114 apparently stores “a number of short executable programs.” (Spaur; col. 8, ll. 62-63). Neither of these descriptions identically discloses (or even suggests) a database consulted by a message dispatcher for selecting a message handler from a set of one or more message handlers, as in claim 1. For at least the reasons discussed above, withdrawal of the anticipation rejection as to claim 1 is respectfully requested.

The Final Office Action’s response to the arguments presented above restates the previously presented grounds for rejection. In particular, the Final Office Action asserts that controller/network protocol converter 30 of Figure 2 of the “Spaur” reference discloses a message dispatcher according to claim 1. However, as explained above, the Final Office Action also asserts that this element of the “Spaur” reference discloses a message handler. Since the method according to claim 1 recites “receiving the message … by a message dispatcher before transmitting the message to a message handler”, it is apparent that the message dispatcher and message handler must be distinct features. This conclusion follows in light of a further feature of claim 1, which states that “the message dispatcher selects the message handler from a set of one or more message handlers by consulting a database.” If, as asserted by the Final Office Action, controller/network protocol converter 30 discloses a message handler, it is clear that only one message handler is shown in Figure 2 of the “Spaur” reference, and therefore the “Spaur” reference does not identically disclose (or even suggest) a message dispatcher selecting from a set of one or more message handlers, as provided for in the context of claim 1.

Furthermore, the Final Office Action cites an additional section of the “Spaur” reference in response to the arguments presented above that the databases assertedly

Appeal Brief – 11403/5

disclosed in the “Spaur” reference do not disclose a database that is consulted by the message dispatcher to select the message handler from one or more message handlers. (Office Action; page 13, ll. 16-18). Data memory 106 and program memory 114 are shown in figure 2 of the “Spaur” reference, but there is no indication that they are consulted by a message dispatcher to determine which of one or more message handlers to which a message is transmitted. The sections of the “Spaur” reference cited in the Final Office Action also do not disclose the claimed consultation.

The first section apparently discusses storing data in data memory 106, (Spaur; col. 10, ll. 58-64), while the second cited section apparently discusses data memory 106 being used to store physical data (Spaur; col. 8, ll. 49-53). The section following the cited section of the Spaur reference is further enlightening in this regard, as it discusses data memory 106 being used to store data that is later transmitted over the internet (Spaur; col. 8, ll. 55-58). Similarly, a reference in this part of the “Spaur” reference illustrates the function of program memory 114, which is to store typically short executable programs (Spaur; col. 8, ll. 61-63). None of these cited sections discuss, or even suggest, accessing data memory 106 for the purpose of selecting a message handler, as with claim 1.

The Final Office Action further asserts that the “Spaur” reference discloses a database according to claim 1 since it “stores the configuration information data, and the data that is useful for commands and requests.” (Office Action; page 14, ll. 15-18; citing Spaur; col. 8, ll. 45-60). However, there is no indication that either of the databases referred to in the “Spaur” reference is consulted by a message dispatcher to determine to which message handler a message should be transmitted. Furthermore, the reference by the Examiner to “configuration information data” is apparently a paraphrase of the “Spaur” reference’s discussion of “[i]n this configuration, the web server 102 is able to access the data memory 106 and obtain such configured data for encapsulation or incorporation in the http format for communication over the Internet 68.” (Spaur; col. 8, ll. 55-58). However, this section refers to data being encapsulated or incorporated in the http format. This is presumably the physical data stored in these elements discussed above. There is no indication that this is configuration data, or more importantly, that it is data being accessed by a message dispatcher to determine to which message handler a message should be transmitted.

The Final Office Action’s following discussion appears to argue that the “Spaur” reference inherently discloses the features of the presently claimed subject matter. (Final

Office Action; page 15, ll. 1-19). In particular, the Final Office Action asserts that a “CPU cannot possibly selects, enables and processes [sic] these elements without the stored/memorized intelligent stored [sic] in the memory.” (Final Office Action; page 15, ll. 5-6, emphasis in original). However, an argument by inherency must show at least that the assertedly inherent features **necessarily follow** from the disclosed structure. The argument in the Final Office Action fails to meet this standard. A processor does not necessarily consult a database to determine to which message handler to send a message. Therefore, the cited reference does not anticipate the subject matter of claim 1.

Claims 3-11 and 13-16 depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 as presented is allowable.

Claim 17 relates to a system that includes a feature similar to the one described above, namely, a message dispatcher adapted to receive a message from a first driver before transmitting the message to a message handler, wherein the message dispatcher is adapted to select the message handler from a set of one or more message handlers by consulting a database. Therefore, for at least the reasons discussed above, withdrawal of the anticipation rejection as to claim 17 is respectfully requested.

Claims 19-27 and 29-32 depend from claim 17 and are therefore allowable for at least the same reasons that claim 1 is allowable.

**B. The Rejections Under 35 U.S.C. § 103(a)  
That Claims 12, 28 and 33 Are Obvious  
Over “Spaur” in view of the “Wunderlich” Reference**

**Claims 12, 28 and 33**

Claims 12, 28, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the “Spaur” reference in view of the “Wunderlich” reference.

As to obviousness, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been

obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Also, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As regards the Background Information, access to vehicle electronics currently requires special hardware that is connected directly to the vehicle bus through an OBDII (On-Board Diagnostic) connector or some other physical connection. Further, hardware that is dedicated to a certain kind of wireless link (e.g., Groupe Spécial Mobile (GSM) phone) has been proposed for remote diagnosis. (See specification, page 1, lines 8 to 11).

Problems with these methods of accessing in-vehicle electronic information include the following: the amount of time for attaching the OBDII connector; delay and difficulty in finding the OBDII connector within the engine bay or other vehicle location; the limitation upon freedom of movement for the operator, since with the connector attached to the vehicle, the operator is forced to avoid the connector line as he moves around the vehicle while repairing the vehicle, etc, which may affect operator efficiency; tripping over the wire as the operator about the vehicle; the necessity of requiring the vehicle for physical attachment to the operator’s equipment, where to access the in-vehicle electronics, an actual physical connection must be made, which may be inconvenient for the vehicle owner; and diagnosing intermittent problems and problems occurring only during vehicle operation, where a vehicle’s electronics cannot be accessed in real time while the car is in motion. (See specification, page 1, line 12 to page 2, line 5).

By providing access the vehicle electronics without a physical connection, the presently claimed subject matter is intended to eliminate these problems, so that there is a

need for a system and method that provides wireless access to a data bus, such as that provided in an automobile (See specification, page 2, lines 6 to 9), which is provided by the presently claimed subject matter.

Claims 12 and 28 depend from claims 1 and 17 as presented, respectively, and are therefore allowable for at least the same reasons as claims 1 and 17 are allowable, as explained above, since the secondary reference does not cure the critical deficiencies of the primary reference.

Independent claim 33 relates to a system for translating a message of a Controller Area Network protocol to a Bluetooth protocol, which includes a message dispatcher adapted to receive the message from the first driver before transmitting the message to the message handler, wherein the message dispatcher is adapted to select the message handler from a set of one or more message handlers by consulting a rules database. As explained above, neither the “Spaur” nor the “Wunderlich” reference discloses or even suggests this feature, and therefore the claim is allowable over the combination of the references.

For at least the reasons discussed above, withdrawal of the obviousness rejections as to claims 12, 28, and 33 is respectfully requested.

As further regards all of the obviousness rejections discussed herein, in rejecting a claim under 35 U.S.C. § 103(a), the *Office* bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also suggest combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Moreover, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is respectfully submitted that, as discussed above, the references relied on, whether taken alone or combined, do not suggest in any way modifying or combining the references so as to provide the presently claimed subject matter for addressing the problems and/or providing the benefits discussed herein and in the specification, as explained above.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Final Office Action’s assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Final Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, it is believed that there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references relied upon makes plain that it simply does not describe the features discussed above of the claims as now presented.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

In short, there is no evidence that the reference relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (See In re Rouffet, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie*

“obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See In re Kotzab, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and this Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (See In re Oetiker, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Accordingly, claims 1, 3 to 17, and 19 to 33 are allowable.

CONCLUSION

In view of the above, it is respectfully requested that the rejections of the finally rejected claims 1, 3 to 17, and 19 to 33 be reversed, and that these claims be allowed as presented.

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Respectfully submitted,

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[11403/5]

CLAIMS APPENDIX

1. (Previously Presented) A method for translating a message of a first protocol received by a first driver to a second protocol transmitted by a second driver, comprising:
  - receiving the message from the first driver by a message dispatcher before transmitting the message to a message handler, wherein the message dispatcher selects the message handler from a set of one or more message handlers by consulting a database;
  - converting the message received by the first driver to an independent format;
  - transmitting the message from the first driver to the second driver via the message handler; and

converting the message received by the second driver in the independent format to the second protocol; where

the first driver and the second driver are located in a vehicle and the first protocol is a vehicular protocol; and

the second protocol is a wireless link.
3. (Previously Presented) The method of claim 1, further comprising:

receiving the message from the message handler by a multiplexer before transmitting the message to the second driver.
4. (Previously Presented) The method of claim 3, wherein the multiplexer utilizes a network configuration unit for at least one of system startup, maintenance, and dynamic reconfiguration.
5. (Previously Presented) The method of claim 1, further comprising:

performing a manipulation on the message in the message handler.
6. (Previously Presented) The method of claim 5, wherein the manipulation includes at least one of packet translation and interaction with a computer application.
7. (Previously Presented) The method of claim 1, further comprising transmitting the message from the second driver to a third driver

Appeal Brief – 11403/5

8. (Previously Presented) The method of claim 3, wherein the multiplexer is a network multiplexer.
9. (Previously Presented) The method of claim 1, wherein the database is a rules database.
10. (Previously Presented) The method of claim 7, further comprising transmitting the message from the second driver to the third driver in the second protocol by wireless communication.
11. (Previously Presented) The method of claim 1, wherein the first protocol is a Controller Area Network protocol.
12. (Previously Presented) The method of claim 1, wherein the second protocol is a Bluetooth protocol.
13. (Previously Presented) The method of claim 10, wherein the message received by the third driver is translated back to the first protocol and received by a fourth driver.
14. (Previously Presented) The method of claim 10, wherein a remote application in communication with the third driver is capable of receiving the message.
15. (Previously Presented) The method of claim 14, wherein the remote application is capable of either passively receiving the message or initiating a transmission from the third driver back to the second driver for translation and receipt at the first driver in the first protocol.
16. (Previously Presented) The method of claim 15, wherein the third driver is unable to communicate with the second driver unless the third driver adheres to predefined transmission rules and transmits messages from only a predefined group of possible messages.
17. (Previously Presented) A system for translating a message of a first protocol to a second protocol, comprising:

a first driver adapted to receive the message of the first protocol and convert the message to an independent format;

a message handler adapted to receive the message from the first driver;

a message dispatcher adapted to receive the message from the first driver before transmitting the message to the message handler, wherein the message dispatcher is adapted to select the message handler from a set of one or more message handlers by consulting a database; and

a second driver adapted to receive the message from the message handler and adapted to convert the message received in the independent format to the second protocol; where

the first driver and the second driver are located in a vehicle and the first protocol is a vehicular protocol; and

the second protocol is a wireless link.

19. (Previously Presented) The system of claim 17, wherein a multiplexer is adapted to receive the message from the message handler before transmitting the message to the second driver.

20. (Previously Presented) The system of claim 19, wherein the multiplexer is adapted to utilize a network configuration unit for at least one of system startup, maintenance, and dynamic reconfiguration.

21. (Previously Presented) The system of claim 17, wherein the message handler is adapted to perform a manipulation on the message.

22. (Previously Presented) The system of claim 21, wherein the manipulation includes at least one of packet translation and interaction with a computer application.

23. (Previously Presented) The system of claim 17, further comprising a third driver coupled to the second driver.

24. (Previously Presented) The system of claim 19, wherein the multiplexer is a network multiplexer.

25. (Previously Presented) The system of claim 17, wherein the database is a rules database.
26. (Previously Presented) The system of claim 17, wherein the message is transmitted from the second driver to a third driver in the second protocol by wireless communication.
27. (Previously Presented) The system of claim 17, wherein the first protocol is a Controller Area Network protocol.
28. (Previously Presented) The system of claim 17, wherein the second protocol is a Bluetooth protocol.
29. (Previously Presented) The system of claim 26, wherein the message received by the third driver is translated back to the first protocol and received by a fourth driver.
30. (Previously Presented) The system of claim 26, wherein a remote application in communication with the third driver is capable of receiving the message.
31. (Previously Presented) The system of claim 30, wherein the remote application is capable of either passively receiving the message or initiating a transmission from the third driver back to the second driver for translation and receipt at the first driver in the first protocol.
32. (Previously Presented) The system of claim 26, wherein the third driver is unable to communicate with the second driver unless the third driver adheres to predefined transmission rules and transmits messages from only a predefined group of possible messages.
33. (Previously Presented) A system for translating a message of a Controller Area Network protocol to a Bluetooth protocol, comprising:
  - a first driver adapted to receive the message of the Controller Area Network protocol and convert the message to an independent format;
  - a message handler adapted to receive the message from the first driver;
  - a second driver adapted to receive the message from the message handler and adapted to convert the message received in the independent format to the Bluetooth protocol;

a message dispatcher adapted to receive the message from the first driver before transmitting the message to the message handler, wherein the message dispatcher is adapted to select the message handler from a set of one or more message handlers by consulting a rules database; and

a third driver coupled to the second driver;

where

the first driver and the second driver are located in a vehicle;

a network multiplexer is adapted to receive the message from the message handler before transmitting the message to the second driver;

the network multiplexer is adapted to utilize a network configuration unit for at least one of system startup, maintenance, and dynamic reconfiguration;

the message handler is adapted to perform a manipulation on the message that includes at least one of packet translation and interaction with a computer application;

the message is transmitted from the second driver to the third driver in the Bluetooth protocol by wireless communication; and

a remote application in communication with the third driver is capable of either passively receiving the message or initiating a transmission from the third driver back to the second driver for translation and receipt at the first driver in the Controller Area Network protocol.

Appeal Brief – 11403/5

**EVIDENCE APPENDIX**

Appellants have not submitted any evidence pursuant to 37 CFR Sections 1.130, 1.131 or 1.132, and do not rely upon evidence entered by the Examiner.

Appeal Brief – 11403/5

RELATED PROCEEDINGS INDEX

There are no interferences or other appeals related to the present application.